

### **REMARKS**

Favorable reconsideration of this application is requested in view of the following remarks. Claim 2 is amended to correct a typographical error. No new matter has been added. Claims 1-19 remain actively pending in the case. Reconsideration of the claim is respectfully requested.

In response to paragraph 3 on page 2 of the Office Action, Applicants have amended the Cross Reference to Related Applications on page 1 of the specification to include the status of the related applications.

In paragraph 4 on page 2 of the Office Action, claim 2 was rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse the rejection but in the interest of furthering prosecution have amended claim 2. Applicants submit that claim 2 is now in condition for allowance and request that Examiner withdraw the rejection.

In paragraph 5 on page 2 of the Office Action, claims 1-19 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-21 of copending Application No. 10/050,979. Applicants respectfully traverse this rejection, but in the interest of expediting prosecution have attached hereto a terminal disclaimer to overcome the objection. Therefore, Applicants' respectfully request that the rejection be withdrawn.

In paragraph 7 on page 3 of the Office Action, claims 1, 3-7, 9-10, 12-16 and 18-19 were rejected under 35 USC §102(e) as being anticipated by Smart et al. (US 2003/0208691). In paragraph 20 on page 7 of the Office Action, claims 2, 8, 11 and 17 were rejected under 35 USC §103(a) as being unpatentable over Smart et al. in view of what was well known in the art.

Smart fails to teach or suggest at least providing an offering at said one order terminal based on a business relationship between the business entity associated with said one order terminal and said digital device provider associated with said digital storage device as required by Applicants' independent claims. Smart discloses that when a new device is connected to a local network 100, a multicast announcement is broadcasted to other users on the network. Accordingly, devices currently on the network learn of the new device, and the

new device learns of the devices currently on the network. For example, a new device, such as a camera 102, can identify the population of devices already connected to the network, and becomes aware of their attributes and capabilities. *See* paragraph [0081]. The new device will then determine if its own attributes (i.e., criterion) are compatible with the equipment currently attached to the network, such as a printer, and if so, will use the currently attached equipment to perform a task, such as printing a document. *See* paragraph [0081], [0082] and [0115]. Further, devices on a large network can use a Service Description Directory that represents devices connected to the large network. *See* paragraphs [0053] and [0054]. Smart may also use other criterion to establish compatibility as disclosed in Table 1 of Smart. *See* page 8.

However, Smart does not disclose a provision for an offering at an order terminal. Also, Smart does not base an offering on a business relationship associated with a digital storage device. At best, Smart uses the profile process to create compatibility matches between devices, such as a camera and a printer. *See* [0115]. In sharp contrast, Applicants' invention first requires information, with respect to a business relationship, between a plurality of digital storage device providers and a plurality of business entities. Accordingly, the price, and number and order of services, offered at an order terminal is based on the business relationships between, for example, a business entity associated with the order terminal and the digital device provider associated with the digital storage device (i.e., the digital storage device includes code which identifies the digital device provider. *see* claim 7). *See* pages 28-32 and Fig. 9 of Applicants' Specification.

In order to render a claim anticipated by the prior art, each and every element of the claim must be disclosed in a single reference. In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303,1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "usually . . .dispositive. . . [and] the single best guide to the meaning of a disputed term." *Id.* (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582). For these reasons, the Federal Circuit confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips*, 415 F.3d at 1317.

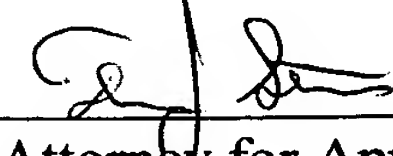
With respect to the Office Action taking official notice to claims 2 and 8, Applicants respectfully assert that an offering price based on business

relationship and a business relationship including, friendly, neutral and hostile relationships, respectively, do not constitute facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. The references relied on by the Examiner, for example, fail to disclose this purportedly "well known" fact. Applicants contend that reasonable doubt exists regarding the circumstances justifying the Examiner's exercise of official notice, and request that the Examiner provide evidence that demonstrates the appropriateness of the officially noticed facts pursuant to MPEP § 2144.03. Applicants reserve the opportunity to respond to the Examiner's comments concerning any such judicially noticed facts.

Therefore, in view of the above remarks, Applicants' independent claims are patentable over the cited reference. Because claims 2-9 and 11-18 depend from claims 1 and 10, respectively, and include the features recited in the independent claim, Applicants respectfully submit that claims 2-9 and 11-18 are also patentably distinct over the cited reference. Nevertheless, Applicants are not conceding the correctness of the Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

  
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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.